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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,602	12/12/2001	Christopher L. Adrien	ERIE-75	5540

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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

EXAMINER	
HANDY, DWAYNE K	
ART UNIT	**PAPER NUMBER**
1743	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,602	ADRIEN ET AL.	
	Examiner	Art Unit	
	Dwayne K. Handy	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5 and 44-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5 and 44-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 5 and 44-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisch (Re. 35,589) in view of Tolles (4,171,866). This rejection was made by the previous Examiner in the previous Office Action (mailed 2/23/06). It remains in effect. Please see Response to Arguments below.

Response to Arguments

4. In response to the previous Office Action, Applicant has amended claim 5 to include the limitations of the cover slip thickness being at least 0.85 mm and the area between the spacer segments as being at least 500 square mm. Applicant has then argued that the prior art does not contain these features. Applicant has also argued that the combined device of Fisch and Tolles does not contain a pair of spacer segments that extend a full length of the cover slip and that the combination of Fisch and Tolles is not obvious since the cited references are directed to a different problem than the problem addressed by Applicant.

5. Obviousness of Fisch combined with Tolles

Applicant has argued that this combination would not be obvious since the cited references are directed to a different problem than that addressed by Applicant. This is a spurious argument. The Examiner reminds Applicant that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would

otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The Examiner need not solve the same problem as Applicant when combining references. The Examiner simply must provide a motivation for the combination and meet the structural limitations of the device. This is what the previous Examiner provided in Paragraph 2 (page 3) when stating that it would have been obvious to combine the devices to allow the sample to be inserted into the chamber while the cover slip is attached to the slide. This would prevent any contamination resulting from inserting the sample and having to add the cover slip to form the chamber.

6. Length of spacer element

Applicant has argued that the combination of Fisch and Tolles does not contain a spacer that extends the length of the slide. The Examiner respectfully disagrees and directs Applicant to Figure 3 of Tolles which shows the Spacer element (19) extending the length of the slide.

7. Area between the spacers and cover thickness

Applicant has amended claim 5 to recite a cover having a thickness of at least 0.85 mm and an area between the spacer segments of at least 500 square mm. Applicant has noted that the sample chambers of Fisch cite dimensions which appear to teach a chamber having an area of about 200 mm. This is based on the grid of 100 squares shown in Figure 1. It appears to the Examiner, however, that there is additional surface area between the spacers that does not include the grid. Therefore, the areas

cited by Applicant represent the *minimum area* between the spacers since there is additional space past the grid. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to enlarge the grid in order to examine as much material as possible from the sample on the grid. This would provide an area between the spacers that is greater than 500 square mm.

Applicant has also argued that 0.85mm is an unobvious thickness given the thickness of the cover in the Tolles reference. Like the previous Examiner, this Examiner takes the position that this thickness does not provide unexpected results over the thickness taught by Tolles. This is especially true given that Applicant's specification does not give this particular thickness any criticality above 0.25 mm and defines the thickness of 0.3 – 2 mm as being sufficient thickness.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
August 21, 2006

JAN LUDLOW
PRIMARY EXAMINER